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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,095	03/23/2004	Scott Manchester	30835/306246	3837
45373 7590 07/27/2009 MARSHALL, GERSTEIN & BORUN LLP (MICROSOFT) 233 SOUTH WACKER DRIVE 6300 SEARS TOWER CHICAGO, IL 60606				
EXAMINER				
ZHANG, SHIRLEY X				
ART UNIT		PAPER NUMBER		
2444				
MAIL DATE		DELIVERY MODE		
07/27/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/807,095

**Applicant(s)**

MANCHESTER ET AL.

**Examiner**

SHIRLEY X. ZHANG

**Art Unit**

2444

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 February 2009 and 12 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 8-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 1-6 and 8-28 were previously pending in the final action mailed on November 13, 2008;

In the most recent amendments filed on February 13, 2009,

No claim is cancelled;

Claims 1, 15 and 21 are amended;

Claims 1-6 and 8-28 are now pending;

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 13, 2009 has been entered.

#### ***Response to Amendments***

2. Applicant's arguments and amendments filed on February 13, 2009 have been carefully considered. As applicant's arguments are directed towards limitations newly added to the claims, the examiner's response can be found below in the "Claim Rejections" section.

#### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over any one of claims 1, 5 or 6 of U.S. Patent No. 6,976,253 to Wierman.

Although the conflicting claims are not identical, they are not patentably distinct from each other because Claims 1, 5 and 6 of Wierman explicitly disclosed all the limitations of claim 1 in the present application except for

“executing by the thin client computing device a configuration program to automatically configure the thin client computing device.”

However, the above cited limitation is obvious in view of Wierman’s disclosure because in order to configure a client computing device such as a mobile device, a configuration program must be executed.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claims 15-20** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**Claim 15** recites “a computer-readable medium”, which appears to be directed to communications media including **signal** and **carrier wave**, according to paragraph [0020] of the application publication U.S. 2005/0198221.

**Claims 16-20** are dependent on claim 15, but failed to further limit the claimed invention to statutory subject matter. Therefore, claims 16-20 inherit the 35 U.S.C. 101 issue of the independent claim.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claim 8** recites the limitation “the configuration log file”. There is insufficient antecedent basis for this limitation in the claim.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 1-2, 4-5, 8-9, 11, 15-17, 20-23 and 25** are rejected under 35 U.S.C. 102(b) as being obvious over Christopherson et al. ( U.S. 2002/0095595, hereinafter “**Christopherson**”).

**Regarding claim 1**, Christopherson disclosed a method of configuring a thin client computing device for operation in a network, comprising:

creating configuration data for the thin client computing device, the configuration data comprising network settings for the thin client computing device to operate in the network (Christopherson, Fig. 1 and [0008] disclosed a system for configuring a client computer connected to a network; [0011] further disclosed that the sets of configuration parameters associated with the tokens may include network configuration parameters indicating network settings the computer uses to communicate over the network);

storing the configuration data on a portable media device (Christopherson, [0044] disclosed that removable non-volatile storage medium may be used to store the configuration parameters);

connecting the portable media device to the thin client computing device (Christopherson, [0044] disclosed that the user can take the removable medium to different client computer 2 machines; here the client computer anticipates the thin client computing device in the claim); and

detecting, by the thin client computing device, the portable media device connected thereto (Christopherson, [0042] disclosed that the configuration unit may be a PCMCIA card that is inserted in a PCMCIA port of the client computer, or it can be any removable non-volatile

storage medium; to support these removal storage medium, the client computer inherently has the capability of detecting the presence of the removable storage medium); and

uploading the configuration data from the portable media device to the thin client computer device (Christopherson, [0044] disclosed that the network machines receiving the non-volatile storage medium would initialize the client computer using the configuration parameters in the storage medium, implying that the configuration parameters will be read into the memory of the client computer first); and

executing by the thin client computing device a configuration program to automatically configure the thin client computing device using the uploaded configuration without using the portable media device (Christopherson, the disclosure in paragraph [0044] implies that the client computer can be configured after the parameters are loaded into the computer's memory, therefore the configuration process can be executed without using the non-volatile medium)

**Regarding claim 2,** Christopherson disclosed a method as in claim 1.

Christopherson further disclosed wherein the steps of creating and storing configuration data are performed on a computer and the step of creating includes prompting a user, through a user interface of the computer, to create network settings for the thin client computing device ([0032] disclosed that the setup utility can receive network and operating system configuration settings through an interactive user interface displayed by the setup utility).

**Regarding claim 4,** Christopherson disclosed a method as in claim 2.

Christopherson further disclosed wherein the step of creating configuration data includes generating, by computer, default values for selected network settings (Christopherson, [0039] disclosed that the setup utility may load certain default sets of configuration parameters into the NVRAM).

**Regarding claim 5**, Christopherson disclosed a method as in claim 4.

Christopherson further disclosed wherein the step of generating default values includes invoking an application program interface (API) of an operating system of the initiating computer to generate the default values for the selected network settings (as is mentioned in claim 4, Christopherson, [0039] disclosed that the setup utility may load certain default sets of configuration parameters into the NVRAM, it is inherent in this process that the loading of default sets of configuration parameters is done via invoking an API of an operating system).

**Regarding claim 8**, Christopherson disclosed a method as in claim 1.

Christopherson further disclosed the steps of: detecting, by the computer, reconnection of the portable media device to the computer (Christopherson, [0044] disclosed using removable storage medium; any computer that supports removable media device inherently has the capability of detecting the reconnection of the device to the computer);  
retrieving, by the computer from the portable media device, the configuration log file written by the thin client computing device (Christopherson, [0044]).

**Regarding claim 9**, Christopherson disclosed a method as in claim 2.



Christopherson further disclosed wherein the step of creating network settings includes receiving network setting data entered by the user (Christopherson, [0006] disclosed that it is known in the prior art that a user can enter networking settings at the client computer).

**Regarding claim 11**, Christopherson disclosed a method as in claim 1.

Christopherson further disclosed wherein the portable media device is a flash memory card (Christopherson, [0042] disclosed that the non-volatile storage medium can be a PCMCIA card, which is a flash memory card).

**Claim 15** list substantially the same elements of **claim 1** in computer readable medium form rather than method form. Therefore, the supporting rationale of the rejection to **claim 1** applies equally as well to **claim 15**.

**Regarding claim 16**, Christopherson disclosed a computer-readable medium as in claim 15.

Christopherson further disclosed wherein the step of automatically configuring includes recognizing that the portable media device contains network settings, and invoking a configuration program to implement the network settings in the computing device (Christopherson, [0033] disclosed that the boot firmware applies the network configuration parameters stored in the NVRAM).

**Regarding claim 17**, Christopherson disclosed a computer-readable medium as in claim 15.

Christopherson further disclosed having further computer-executable instructions for performing the step of writing settings configured on the thin client computing device into the portable media device (Christopherson, [0044] disclosed that removable non-volatile storage medium may be used to store the configuration parameters, which action is inherently performed by computer-executable instructions).

**Regarding claim 20**, Christopherson disclosed a computer-readable medium as in claim 15.

Christopherson further disclosed wherein the portable media device is a flash memory card (Christopherson, [0042] disclosed that the non-volatile storage medium can be a PCMCIA card, which is a flash memory card).

**Regarding claim 21**, Christopherson disclosed a thin client computing device comprising:

- a microprocessor circuit ([0018] disclosed that the client computer includes a CPU);
- a media port for receiving a portable media device ([0042] disclosed a PCMCIA port of the client computer);
- and a memory containing computer-executable instructions for execution by the microprocessor circuit for detecting connection of a portable media device to the media port ([0018] disclosed that the client computer includes a memory, which inherently contains

computer-executable instructions for execution by the microprocessor; [0042] further disclosed that the configuration unit may be a PCMCIA card that is inserted in a PCMCIA port of the client computer, or it can be any removable non-volatile storage medium; to support these removal storage medium, the client computer inherently has the capability of detecting the presence of the removable storage medium),

the portable media device comprising configuration data including network settings for the thin client computing device (Christopherson, [0044] disclosed that removable non-volatile storage medium may be used to store the configuration parameters); and

automatically uploading the configuration data from the portable media device to the thin client computer device (Christopherson, [0044] disclosed that the network machines receiving the non-volatile storage medium would initialize the client computer using the configuration parameters in the storage medium, implying that the configuration parameters will be read into the memory of the client computer first); and

configuring the thin client computing device for operation in a network using the uploaded configuration data and without using the configuration data contained in the portable media device (Christopherson, [0033] disclosed that the boot firmware, a program executing on the client computer, loads network configuration parameters stored in the NVRAM; this combined with the disclosure in paragraph [0044] implies that the client computer can be configured after the parameters are loaded into the computer's memory, therefore the configuration process can be executed without using the non-volatile medium).

**Regarding claim 22**, Christopherson disclosed a thin client computing device as in claim 21.

Christopherson further disclosed wherein the memory contains computer-executable instructions for execution by the microprocessor circuit for recognizing that the portable media device contains network settings, and invoking a configuration program to implement the network settings in the thin client computing device ([0033] disclosed that the boot firmware applies the network configuration parameters stored in the NVRAM).

**Regarding claim 23**, Christopherson disclosed a thin client computing device as in claim 21.

Christopherson further disclosed wherein the memory contains computer-executable instructions for execution by the microprocessor circuit for writing settings configured on the thin client computing device into the portable media device (page 5, claim 1 disclosed storing sets of configuration parameters in the non-volatile storage unit).

**Regarding claim 25**, Christopherson disclosed a thin client computing device as in claim 21.

Christopherson further disclosed wherein the media port is a flash card slot ([0042] disclosed a PCMCIA port that is a flash card slot).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claim 3** is rejected under 35 U.S.C. 103(a) as being unpatentable over Christopherson as applied to claim 2 above, further in view of the web article "Using XML Based Configuration File in Windows Form Applications" authored by Daniel, Olson.

**Regarding claim 3**, Christopherson disclosed a method as in claim 2.

Christopherson further disclosed wherein the step of storing stores the configuration data on the portable media device ([0044] disclosed that removable non-volatile storage medium may be used to store the configuration parameters).

Christopherson does not explicitly disclose that the step further includes generating an Extensible Markup Language (XML) file containing the network settings for the thin client computing device.

However, at the time the invention was made, it was already well known that configuration data can be stored in a file using XML format, as evidenced by Olson's disclosure.

Therefore it would have been obvious for one of ordinary skill in the art to generate an XML file containing the network settings for the thin client computing device. And the

motivation to combine would have come from the fact that storing configuration data in XML was knowledge generally available to one of ordinary skill.

2. **Claims 6, 10, 19 and 24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Christopherson as applied to claims 1 and 21 above respectively, in view of Serceki et al. (U.S. 2003/0078072, hereinafter “**Serceki**”).

**Regarding claim 6**, Christopherson disclosed a method as in claim 2.

Christopherson further disclosed that wireless transmission media as a possible media connection in the preferred embodiment ([0041] disclosed “wireless transmission media”).

Christopherson did not explicitly disclose generating a security key for the wireless network.

However, Serceki disclosed generating and storing a security key for the wireless network in a portable device 200 (Serceki, Figs. 2, 4, [0027] and [0032]).

One of ordinary skill in the art would have been motivated to combine Christopherson and Serceki because both disclosed storing configuration parameters for network clients in a portable device and then configuring the clients using the data stored on the portable device (Christopherson, [0044]; Serceki, “Abstract”).

Therefore, it would have been obvious for one of ordinary skill in the art to integrating Christopherson and Serceki so that Christopherson’s NVRAM stores the security key as one of the network setting parameters. The combination would have allowed the security keys in a

wireless network to be periodically updated without having to ask a user to manually enter the key into a client device, making the system more user friendly and the update more secure.

**Regarding claims 10, 19 and 24**, Christopherson disclosed a method as in claim 1, a computer-readable medium as in claim 15, and a thin client computing device as in claim 21, respectively.

Christopherson did not explicitly disclose that the portable media device is a universal serial bus (USB) flash drive, or the media port is a USB port.

However, Serceki disclosed that the connector for the portable device is preferably a USB port (Serceki, [0029]).

One or ordinary skill in the art would have been motivated to combine Christopherson and Serceki because both disclosed storing configuration parameters for network clients in a portable device and then configuring the clients using the data stored on the portable device (Christopherson, [0044]; Serceki, "Abstract").

Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to use USB flash connector/port disclosed by Serceki as a possible connector choice for the portable media device in Christopherson, as Christopherson invention does not limit the connector to any specific type.

3. **Claims 12-14, 18, and 26-28** are rejected under 35 U.S.C. 103(a) as being unpatentable over Christopherson as applied to claim 1 above, in view of **Takenaka** (U.S. 6,411,829).

**Regarding claims 12, 18 and 26**, Christopherson disclosed a method as in claim 1, a computer-readable medium as in claim 15 and a thin client computing device as in claim 21.

Christopherson does not explicitly disclose the steps of signaling by the thin client computing device a completion of configuration operation after the thin client computing device is configured using the configuration data stored on the portable media device.

However, Takenaka disclosed using audio or visual signal to indicate the completion of charging in column 4, lines 57-67 and column 5, lines 1-15.

It would have been obvious for one of ordinary skill to modify Christopherson with Takenaka's audio and visual signaling technique so that the client computer will signal a completion of configuration operation. One would have been motivated to combine as such by the fact that the thin client in the current invention is similar to the mobile device disclosed in Takenaka, therefore the combination would have yielded a predictable result.

**Regarding claims 13 and 27**, Christopherson disclosed a method as in claim 12, and a thin client computing device as in claim 26.

Christopherson does not explicitly disclose but Takenaka disclosed the step of signaling includes flashing a light-emitting diode (LED) on the thin client computing device (Takenaka, column 5, line 12 disclosed signaling the completion of charging by flashing the LED).

The motivation to combine Christopherson and Takenaka is the same as that stated for claims 12 and 18 above.

**Regarding claims 14 and 28**, Christopherson disclosed a method as in claim 12, and a thin client computing device as in claim 26.



Christopherson does not explicitly disclose but Takenaka disclosed the step of signaling includes displaying a message on a liquid crystal display (LCD) screen of the thin client computing device (Takenaka, column 5, lines 8-9 disclose the method of controlling the display section for displaying the completion of charging).

The motivation to combine Christopherson and Takenaka is the same as that stated for claims 12 and 18 above.

### *Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHIRLEY X. ZHANG whose telephone number is (571)270-5012. The examiner can normally be reached on Monday through Friday 7:30am - 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Shirley X. Zhang/  
Examiner, Art Unit 2444

/William C. Vaughn, Jr./  
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